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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,447	03/26/2001	Fumitaka Toyomura	35 .G2756	6745

5514 7590 07/31/2002

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NEW YORK, NY 10112

EXAMINER

ODA, CHRISTINE K

ART UNIT	PAPER NUMBER
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2858

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DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,447

Applicant(s)

Toyomura, Manabe & Takehara

Examiner

Christine K. Oda

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2858



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Part III. ELECTION/RESTRICTION

RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. §121:

5 Invention I: Claims 1-15, drawn to method/apparatus comprising performing one of a withstand voltage test or an insulation resistance test on a solar cell and outer housing, classified in Class 324, Subclass 541.

 Invention II: Claim 16, drawn to an insulation resistance measuring apparatus, classified in Class 324, Subclass 525.

10 Invention III: Claim 17, drawn to a withstand voltage tester, classified in Class 324, Subclass 76.39.

2. The inventions are distinct, each from the other because:

A. Inventions I and II/III are related as combination and subcombination.

15 Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations, M.P.E.P. §806.05(c). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all the limitations of Groups II/III (subcombination B_{sp}) such as applying a voltage across test terminals, are not found in Group I (AB_{bd}) as evidenced in
20 Claims 1, 7, 8, and 14-15, the subcombination has separate utility such as testing for faults in numerous devices, such as semiconductors, vehicle wiring, flashlights, fuses, etc.

25 B. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable, M.P.E.P. §806.05(d). In the instant case, invention II has separate utility as an insulation resistance tester, and invention II has separate utility as a withstand voltage tester.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have

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acquired a separate status because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be
5 traversed (37 C.F.R. §1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be
10 accompanied by a diligently-filed petition under 37 C.F.R. §1.48(b) and by the fee required under 37 C.F.R. §1.17(h).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine K. Oda whose telephone number is (703) 305-
15 3857. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, N. Le, can be reached on (703) 308-0750.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0956.

20 A Technology Center fax for FILING Technology Center 2800 PAPERS ONLY is available at (703) 308-7722 or (703) 308-7724.

CKO: cko
29 July 2002

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Christine K. Oda
Christine K. Oda
Primary Examiner
Art Unit 2858